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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,116	01/14/2004	Karoleen B. Alexander	42635-0200	2947
21611	7590	02/10/2006	EXAMINER	
SNELL & WILMER LLP 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626			PARSLEY, DAVID J	
			ART UNIT	PAPER NUMBER
			3643	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/757,116	ALEXANDER, KAROLEEN B.	
	Examiner	Art Unit	
	David J. Parsley	3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Amendment

1. This office action is in response to applicant's amendment dated 12-14-05 and this action is final.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over 5,396,731 to

Byrne in view of U.S. Patent No. 5,678,353 to Tsao et al.

Referring to claim 1, Byrne discloses a structure for use as a tree well skirt or sidewalk comprising, a base layer – at 16, of rubber and a binder – see for example column 4 lines 53-68 and column 5 lines 1-22, and a wear layer – at 30,31, and a binder on top of the base layer – see at 15 in figure 8 and columns 4-5. Byrne does not disclose the wear layer is made of EPDM.

Tsao et al. does disclose a wear layer – at 1-4 made of EPDM – see for example claim 13 column 10 lines 4-14. Therefore it would have been obvious to one of ordinary skill in the art to take the

device of Byrne and add the wear layer made of EPDM of Tsao et al., so as to allow for the device to be durable for outdoor use.

Claims 2-3, 6-11, 12/10, 12/11, 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne as modified by Tsao et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,730,773 to Farley.

Referring to claim 2, Byrne as modified by Tsao et al. does not disclose the base layer is butadiene rubber. Farley does disclose the base layer is butadiene rubber – see for example column 4 lines 28-44. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and add the base layer of butadiene rubber of Farley, so as to allow for the device to be flexible and resilient.

Referring to claim 3, Byrne as modified by Tsao et al. and Farley further discloses the rubber is recycled vehicle tires or industrial rubber – see for example column 4 lines 17-27 of Byrne and column 4 lines 28-44 of Farley.

Referring to claim 6, Byrne as modified by Tsao et al. and Farley further discloses the rubber is in granular form – see for example column 4 lines 17-27 of Byrne and column 4 lines 33-67 of Farley.

Referring to claim 7, Byrne as modified by Tsao et al. and Farley further discloses the rubber granules are in the range of 1.5mm to 6mm – see for example column 4 lines 17-27 of Byrne.

Referring to claim 8, Byrne as modified by Tsao et al. and Farley further discloses the rubber is in the form of peelings or buffings – see for example column 4 lines 17-27 of Byrne.

Referring to claim 9, Byrne as modified by Tsao et al. and Farley further discloses the rubber is in the form of a mixture of granules and peelings and buffings – see for example column 4 lines 17-27 of Byrne.

Referring to claims 10-11, Byrne as modified by Tsao et al. and Farley does not disclose the mixture of granules to peelings or buffings is either 70% granules and 30% peelings or buffings or 50% granules and 50% peelings or buffings. However, these are limitations found through experimentation and it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and Farley and add the mixture of either 50 or 70% buffings and either 30 or 50% peelings or buffings, so as to allow for the device to be of a natural appearance.

Referring to claims 12/10 and 12/11, Byrne as modified by Tsao et al. and Farley further discloses the rubber is recycled vehicle tires or industrial rubber – see for example column 4 lines 17-27 of Byrne and column 4 lines 28-44 of Farley.

Referring to claims 13-14, Byrne as modified by Tsao et al. and Farley does not disclose the base layer is 1 ½ to 3 ½ inches or 2 inches thick. However, these limitations are found through experimentation and it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and Farley and add the base layer being 1 ½ to 3 ½ inches or 2 inches thick, so as to allow for the device to be made of sufficient size to make the device durable for outdoor use.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne as modified by Tsao et al. and Farley as applied to claim 2 above, and further in view of U.S. Patent No. 4,882,386 to Stella.

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Referring to claim 4, Byrne as modified by Tsao et al. and Farley does not disclose the binder is isocyanate polyurethane. Stella does disclose the binder is isocyanate polyurethane – see for example column 9 lines 19-26. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and Farley and add the binder being isocyanate polyurethane of Stella, so as to allow for the device to be strengthened and thus more durable.

Referring to claim 5, Byrne as modified by Tsao et al., Farley and Stella does not disclose the ratio of binder to rubber is 16% by weight. However, this limitation is found through experimentation and it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al., Farley and Stella and add the ratio of binder to rubber being 16% by weight, so as to allow for the device to be strengthened and thus more durable.

Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne as modified by Tsao et al. as applied to claim 1 above, and further in view of Stella.

Referring to claim 15, the binder is isocyanate polyurethane. Stella does disclose the binder is isocyanate polyurethane – see for example column 9 lines 19-26. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and add the binder being isocyanate polyurethane of Stella, so as to allow for the device to be strengthened and thus more durable.

Referring to claim 16, Byrne as modified by Tsao et al. and Stella does not disclose the ratio of binder to rubber is 20% by weight. However, this limitation is found through experimentation and it would have been obvious to one of ordinary skill in the art to take the

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device of Byrne as modified by Tsao et al. and Stella and add the ratio of binder to rubber being 20% by weight, so as to allow for the device to be strengthened and thus more durable.

Referring to claim 17, Byrne as modified by Tsao et al. and Stella further discloses the rubber is granular – see for example column 4 of Byrne.

Referring to claim 18, Byrne as modified by Tsao et al. and Stella further discloses the rubber granules are in the range of 1.5mm to 6mm – see for example column 4 lines 17-27 of Byrne.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne as modified by Tsao et al. as applied to claim 1 above, and further in view of U.S. Patent No. 4,205,102 to Schuurink et al.

Referring to claim 19, Byrne as modified by Tsao et al. does not disclose the binder contains aliphatic diisocyanate. Schuurink et al. does disclose the binder contains aliphatic diisocyanate – see for example claim 3. Therefore, it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and add the binder containing aliphatic diisocyanate of Schuurink et al., so as to allow for the device to be strengthened and thus more durable.

Referring to claim 20, Byrne as modified by Tsao et al. and Schuurink et al. further discloses the rubber is granules and the granules are in the range of 1.5mm to 6mm in diameter – see for example column 4 lines 17-27 of Byrne.

Referring to claim 21, Byrne as modified by Tsao et al. and Schuurink et al. does not disclose the base layer 2 to 3 inches thick and the wear layer is 3/8 to 1/2 inch thick. However, these limitations are found through experimentation and it would have been obvious to one of

ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and Schuurink et al. and add the base layer being 2-3 inches thick and the wear layer being 3/8-1/2 inch thick, so as to allow for the device to be of sufficient size to be durable for outdoor use while not being too bulky for transport.

Response to Arguments

3. Applicant's amendments dated 12-14-05 overcome the 35 U.S.C. 112 2nd paragraph rejections set forth in the office action dated 6-15-05.

Regarding the prior art rejections to claim 1, the Byrne reference US 5396731 does disclose two materially different layers as seen in figure 8 where there are upper and lower layers – at 15,16 and middle layer – at 30, which is materially different than the layers – at 15 and 16. Applicant argues that the Tsao et al. reference US 5678353 does not disclose a wear layer composed of EPDM and a binder. However, as seen in claim 1 the wear layer is only disclosed as containing EPDM and not a binder and therefore this argument is deemed moot.

Regarding the prior art rejection to claim 2, the Farley reference US 5730773 does disclose the device is made of a butadiene rubber as seen in claim 3 in column 8 lines 57-62.

Regarding the prior art rejections to claims 10-11, applicant argues that the ratio of granules and buffings is not a claim limitation found through experimentation. However, applicant offers a statement of opinion that this is the case and offers no factual evidence supporting this argument. Further, applicant's disclosure does not indicate that the ratios as claimed are critical to the operation of the device in view of other values for the ratios and therefore applicant's arguments are not persuasive.

Regarding the prior art rejections of claims 13-14, applicant argues that the thickness values as claimed cannot be found through routine experimentation. However, applicant's disclosure does not indicate that the thickness values as claimed are critical to the operation of the device in view of other values for the thickness and therefore applicant's arguments are not persuasive.

Regarding the prior art rejection of claim 4, the Stella reference US 4882386 discloses a rubber product made with an isocyanate adhesive/binder as seen in the abstract.

Regarding the prior art rejection of claim 5, applicant argues that the ratio of first binder to butadiene rubber as claimed cannot be found through routine experimentation. However, applicant's disclosure does not indicate that the ratio as claimed is critical to the operation of the device in view of other values for the thickness and therefore applicant's arguments are not persuasive.

Regarding the prior art rejections of claims 15-16, the prior art references disclose the claimed invention as seen above in paragraph 2 of this office action.

Regarding the prior art rejections of claims 19-20, applicant relies upon the arguments to claim 1 therefore see the response to these arguments above in this paragraph of the office action.

Regarding the prior art rejection of claim 21, applicant argues that the thickness values as claimed cannot be found through experimentation. However, applicant's disclosure does not indicate that the values for the thickness are critical to the operation of the invention and therefore applicant's arguments are not persuasive.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Parsley whose telephone number is (571) 272-6890. The examiner can normally be reached on Monday-Friday from 8am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Parsley
Patent Examiner
Art Unit 3643



PETER M. POON
SUPERVISORY PATENT EXAMINER

2/6/06